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DOCKET NO. PHN 17,062
U.S. SERIAL NO. 09/368,852
PATENT

REMARKS

Claims 1–20 are pending in the present application.

Claims 1–7 and 9 were amended to eliminate the European-style transition phrase “characterized in that . . .” and to conform the claims to conventional United States claim structure and punctuation.

Claims 1 and 11 were further amended to explicitly recite that the selected signal-processing operation is performed to obtain the processed signal. As this limitation was implicit in the claims as filed, the scope of the claims has not been altered by the amendment.

Claim 7 was amended to clarify the intended meaning of displaying the demonstration signal with the selected signal-processing operation “activated” and “deactivated.”

Claims 12–20 were added.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 103 (Obviousness)

Claims 1–11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,266,098 to *Cove et al* in view of U.S. Patent No. 5,724,102 to *Harrison et al*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis

to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Independent claims 1 and 11 each recite that a stored demonstration signal is employed to display the effect of performing a selected signal-processing operation. Such a feature is not shown or suggested by the cited references, taken alone or in combination. *Harrison et al* discloses a simple information retrieval system with user help for locating desired information. *Cove et al* discloses a conventional video receiver with no special capabilities for demonstrating the effect of a selected signal processing operation. Neither reference teaches or suggests a demonstration signal specifically selected to demonstrate the effect of a signal-processing operation. Moreover, the references fail to provide a reasonable expectation of success in achieving the claims invention the usefulness that information retrieval as taught by *Harrison et al* to guiding users through television monitor parameter selection with a system of the type disclosed in *Cove et al*, as proposed in the Office Action, is irrelevant to displaying the effect of a signal-processing operation. Such a combination would not inherently and necessarily produce a demonstration of the effect of a signal-processing operation since no specifically selected demonstration signal is shown or suggested, and the incoming video signal received by the system taught by *Cove et al* may not be suitable for demonstration of the effect of the selected signal-processing operation.

Claim 5 further recites automatically repeating a moving video presentation based on the demonstration signal. Such a feature is not shown or suggested by the cited references, taken alone or in combination.

Claim 6 further recites alternately activating and deactivating the selected signal-processing

operation during presentation of the demonstration signal. Such a feature is not shown or suggested by the cited references, taken alone or in combination.

Claim 7 further recites providing a split screen and displaying the demonstration signal processed according to the selected signal-processing operation on one portion and the demonstration signal NOT processed according to the selected signal-processing operation on the other portion. Such a feature is not shown or suggested by the cited references, taken alone or in combination.

Therefore, the rejection of claims 1-11 under 35 U.S.C. § 103 has been overcome.



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AMENDMENTS WITH MARKINGS TO SHOW CHANGES MADE

Claims 1-7, 9 and 11 were amended herein as follows:

1 1. (Amended) A device for demonstrating an effect of a selected signal-processing operation,
2 said device comprising:
3 a signal-processing device for processing an incoming signal according to said selected
4 signal-processing operation to supply a processed signal to presentation means[,]; and
5 demonstration means for controlling the signal-processing device to perform said selected
6 signal-processing operation in response to a user command, [characterized in that] the demonstration
7 means [further comprise] comprising:
8 storage means for storing a demonstration signal selected to allow an effective
9 demonstration of the particular processing operation[,]; and
10 directing means of directing the demonstration signal to the signal processing device
11 in response to said user command.

1 2. (Amended) A device as claimed in claim 1, [characterized in what] wherein the directing
2 means further comprise;

3 switching means for supplying, in response to said user command, either in incoming signals
4 or the demonstration signals to the signal-processing device.

1 3. (Twice amended) A device as claimed in claim 1, [in which] wherein said incoming
2 signals are video signals and said presentation means comprises a display screen, [characterized in
3 that] and wherein the storage means are adapted to contain a static picture.

1 4. (Amended) A device as claimed in claim 3, [characterized in that] wherein the storage
2 means are adapted to contain further pictures, the demonstration means being adapted to present said
3 picture and said further pictures consecutively as a moving video presentation.

1 5. (Amended) A device as claimed in claim 4, [characterized in that] wherein the
2 demonstration means are further adapted to repeat the moving video presentation automatically.

1 6. (Twice amended) A device as claimed in claim 1, [characterized in that] wherein the
2 demonstration means are further adapted to activate and deactivate said processing operation
3 alternately during the presentation of the demonstration signals.

1 7. (Twice amended) A device as claimed in claim 1, [characterized in that] wherein the
2 demonstration means are further adapted to present the demonstration signals in a split screen form,
3 one part of the display screen showing a presentation of the demonstration signals having been
4 processed according to said selected processing operation [activated] and another part of the display
5 screen showing a presentation of the demonstration signals having not been processing according
6 to said processing operation [deactivated].

1 9. (Amended) An apparatus as claimed in claim 8, comprising a number of user operable
2 means for controlling functions of the apparatus, [characterized in that] wherein said user command
3 comprises the operation of a single one or a combination of said control means for a predetermined
4 period of time.

1 11. (amended) A method of demonstrating an effect of a selected signal-processing operation,
2 the method comprising the steps of:
3 processing an incoming signal to supply a processed signal to presentation means[,]; and
4 controlling said selected signal-processing operation to be performed in response to a user
5 command[, characterized in that the method comprises a step of] by:
6 reading a demonstration signal from storage means, which demonstration signal has
7 been selected to allow an effective demonstration of said selected processing operation[,]; and [a step
8 of]
9 processing the demonstration signal according to said selected processing operation
10 in response to said user command.

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SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of pending claims and that this Application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@novakov.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

NOVAKOV DAVIS & MUNCK, P.C.

Date: March 4, 2002

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